

Appl. No. 10/022,924
Amendment Dated June 2, 2005
Response to Office Action Mailed March 25, 2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 25, 2005 in the above-identified application for Letters Patent.

Amendments to the Specification

The Specification has been amended at page 1 to correct the incorrect identification of the present application as a continuation in part of application Serial No. 09/870,538, filed on May 30, 2001 and to update the status of application Attorney Docket No. 8522.

Amendments to the Claims

Claims 1 - 31 were originally presented for examination.

Claims 1 and 5 are currently amended herein.

Claims 2 - 4, 6 - 9 and 11 - 31 are cancelled herein.

Claims 1, 5 and 10 remain in the application.

Amendments to the Drawings

A copy of Fig. 3, which was inadvertently omitted when the present application was originally filed, is enclosed as an attachment to this paper.

Response to the Office Action

As noted in paragraph 3. of the Office Action, Claims 1, 3 - 5 and 10 - 30 stand rejected under 35 U.S.C. 102 (e) as being disclosed by Minegishi (U.S. Pat.

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AMENDMENTS TO THE DRAWINGS

As noted in Section 1 of the Office Action, Fig. 3 is missing from the drawings submitted on 12/18/01. Applicants respectfully submit that the omission of Fig. 3 was an inadvertent error. Attached herewith is a copy of Fig. 3 labeled in the top margin as a "New Sheet" pursuant to 37 CFR 1.121 (d). This drawing, inadvertently omitted when the original application was filed, does not constitute or include new matter in that this drawing is identified as Fig. 3 in the second paragraph of page 9 of the specification under the Section Brief Description of the Drawings and described and it is also made reference to on pages 18 and 21 - 23 of the original specification.

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Pub. No. 2002/0051197) (Public Line connection Device for Printer and Print System).

As noted in paragraph 4. of the Office Action, Claims 1 - 5, 10, 12 - 21 and 24 - 31 stand rejected under 35 U.S.C. 102(e) as being disclosed by Miller, Jr. et al. (U.S. Pat. No. 6,356,356) (System and Method for Transmitting a Fax to an E-Mail Address).

As noted in paragraph 5. of the Office Action, Claims 1, 4, 6 - 10, 12 - 20 and 24 - 31 stand rejected under 35 U.S.C. 102(e) as being disclosed by Forth (U.S. Pat. No. 6,473,498) (Method and System for Maximizing Use of a Communication Line).

Because original Claims 2 - 4, 6 - 9 and 11 - 31 have been cancelled, their respective rejections in the Office Action are now moot and need not be addressed in this paper.

As noted in the Summary of the Invention: beginning on page 5 of Applicants' specification:

Techniques are disclosed for coupling a printer to a communications network (such as a Plain Old Telephone Service network), downloading printing information (such as a digital image) to the printer over the communications network, and using the printer to print output based on the printing information. Downloads may be interrupted and subsequently resumed from the point of interruption.

This interrupt and subsequent resumption of the downloading of printing information feature of the present information is noted on pages 7 and 8 of the present application as follows:

If the download of printing information to the printer is interrupted, the printer may terminate its connection to the printing server. For example, if the printer is connected to the printing server over a POTS telephone line that has call waiting enabled, the printer may terminate its connection to the printing server in response to receipt of an incoming call on the telephone call during a download. The user may then answer the phone and engage in a voice telephone call over the telephone line. Upon termination of the voice telephone call, a connection between the printer and the server may be re-established over the telephone line and the previously interrupted download may be resumed from the point at which it was interrupted. For example, the printer may automatically call the server to resume the interrupted download upon termination of the user's voice telephone call. The ability to interrupt and resume downloads may be used to allow incoming telephone calls to be received during a download and therefore to facilitate use of a single telephone line for downloading printing information and for voice telephone calls.

This termination of the connection with the print server and its re-establishment, upon termination of the voice conversation, for subsequent resumption of the downloaded printing information feature is also disclosed at page 13 of the present application beginning with the third paragraph.

Certain aspects of the interrupt/re-establish the connection between the printer and print server were found in the original Claims 1, 2, 4 and 6 - 9.

To more clearly and patentably distinguish over the cited prior art, the limitations of Claims 1, 2, 4 and 6 - 9 have now been incorporated in Claim 1 (currently amended) herein, and further limitations including; the line used to connect the printer with the printer server is shared with a user's voice communication telephone having call waiting enabled; the interrupting signal is a detected call waiting signal; and following the termination of the voice conversation, *automatically* re-establishing a connection between the printing server and the printer.

For convenience, Claim 1 (currently amended) is re-produced here:

Claim 1 (currently amended): A method for downloading and printing information stored on a remote print server that is accessible by a modem equipped printer via a POTS telephone line which is shared with a user's voice communications telephone having call waiting service enabled, said method comprising steps of:

- (A) initiating a connection between a the printer and a printing server over a POTS telephone network by dialing a telephone number associated the printer server; and
- (B) at the printer, performing steps of:
 - (1) downloading printing information from the printing server through the connection; and
 - (2) printing the printing information.
- (C) interrupting step (B) (1) if an interrupting signal is detected on the connection between the printing server and the printer including terminating the connection with the print server when an interrupting call waiting signal is detected thereby allowing the user to establish a voice conversation with a party associated with the call waiting signal;
- (D) following the termination of the voice conversation, automatically re-establishing a connection between the printing server and the printer; and
- (F) at the printer, resuming download of the printing information from the printing server through the re-established connection.

In rejecting the original Claim 9, the Office Action states at paragraph 5.6 :

5.6 Regarding claim 9, Foth discloses the method of claim 6, further comprising steps of: (D) re-establishing a connection between the printing server and the printer; and (E) at the printer, resuming

download of the printing information from the printing server through the re-established connection (Fig. 3, item 140; col. 5, lines 2— 10 “the document transmission is stored in memory 140 for later transmission.”).

The Applicants respectfully disagree with this assertion.

In the present invention, the connection between the print server and printer is to download printing information from the print server to the printer. That is, the printer is receiving incoming information. The connection that is terminated in the Applicants' invention is delivering *incoming* information. When this connection is later re-established, it is for the purpose for resuming downloading of the printing information which is *incoming* information being *received* by the printer.

The portion of Foth cited in the Office Action in support of disclosing the re-establishment of the connection, ((Fig. 3, item 140; col. 5, lines 2— 10 “the document transmission is stored in memory 140 for later transmission.”) is referring to outgoing – not incoming – information.

More specifically, beginning at column 4, line 67 and continuing through column 5, line 7, Foth states:

“The method of FIG. 6 begins at step 500 where the user prompts facsimile component to *send a document transmission* (emphasis added). The method continues to step 510 where monitor/switch 120 queries as to whether or there is a voice call in progress. If the answer to the query is ““yes”” then the method proceeds step 520 where the document transmission is stored in memory 140 for later transmission.”

Accordingly, this disclosure, in the particular section of Foth relied on in the Office Action to reject claim 9, is not effective as a reference against Claim 1

(currently amended) because it does not disclose the termination of a connection carrying *incoming* information for the printer, the re-establishment of a terminated connection, nor does it disclose that upon termination of the voice conversation a previously terminated connection carrying incoming information is *automatically re-established* to resume downloading of printing information.

Foth does disclose the termination of connection carrying incoming faxes being received. However, he does not disclose, teach, suggest or hint that after termination, the connection is to be re-established to resume reception of an incoming fax. Nor does he disclose, teach, suggest or hint that upon termination of a voice conversation the connection is automatically re-established.

In Figure 6, step 580 is labeled “HANG UP FAX BEING RECEIVED SWITCH TO OUTGOING FAX TRANSMISSION.”

At column 5, lines 20-31, Foth states:

“If, however, the answer to the query at step 560 is ““yes”” then the method proceeds to step 580 where the facsimile being *received* is *disconnected* and the monitor/ switch 120 enables the outgoing facsimile to be sent. (emphasis added)”.

There is no disclosure or suggestion in Foth that the connection that is disconnected in step 580 is to be later re-established to resume reception of the “fax being received”.

Also, in Fig. 7, step 790 is labeled “WAIT FOR A PREDETERMINED PERIOD OF TIME THEN IF NECESSARY DISCONNECT FAX” and it is associated

with a fax being received in step 770 labeled “FAX BEING RECEIVED FROM PRIORITY DESIGNATION”.

At column 6, lines 15 - 19, Foth states:

“If, however, the facsimile being *received* is not a priority transmission, then the method progresses to step 790 and waits for a predetermined period of time for the facsimile transmission to terminate (to allow the reception to possibly complete (emphasis added).”

Again, there is no disclosure or suggestion in Foth that the connection that is disconnected in step 790 is to be later re-established to resume reception of the “fax being received”.

With regard to Claim 1 (currently amended) Foth does not disclose, teach, suggest or hint that after termination of a connection carrying *incoming* printing information that is being sent from a printer server and is being received by a printer that the connection is to be re-established to resume reception of an incoming printing. Nor does he disclose, teach, suggest or hint that upon termination of a voice conversation the connection is *automatically re-established*. Neither of the other two cited references, Minegishi or Miller disclose, teach, suggest or hint at the invention set forth in Claim 1 (currently amended). Accordingly, Applicants respectfully submit that these three cited references, taken alone, or in any combination, do not disclose, or render unpatentable the invention set forth in Claim 1 (currently amended) and, therefore, Claim 1 (currently amended) should be allowed.

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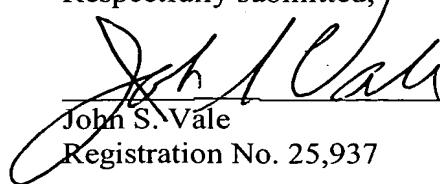
Claims 5 and 10 depend directly from currently amended Claim 1 and add further limitations thereto. Claim 2 adds the limitation that the printing information is processed printing information and that prior to step (B) the method further includes the step of modifying source printing information based on capabilities of the printer to produce the processed printing information. Claim 10 adds the limitation that the printing information comprises a graphical image, and wherein the step (B)(2) comprises a step of printing the graphical image on an output medium.

When the limitations of Claims 5 and 10 are each added to Claim 1, a novel combination of elements is created to define particular aspects of the present invention and such novel combinations are not disclosed, taught or suggested in the three cited references (Minegishi, Miller and Foth) whether taken alone or in any combination.

For these reasons, and those set forth above regarding currently amended Claim 1, Applicants respectfully submit that Claims 5 and 10 clearly and patentably distinguish over the cited prior art and should be allowed.

For all of the above reasons, Applicants submit that the Specification and Claims are now in proper form, and that the Claims all patentably define over the prior art. Therefore, Applicants submit that this Application is now in condition for allowance, which action they respectfully solicit.

Respectfully submitted,



John S. Vale
Registration No. 25,937

Polaroid Corporation
Patent Department
1265 Main Street
Waltham, MA 02451
Tel.: 781-386-6405
Fax: 781-386-6435

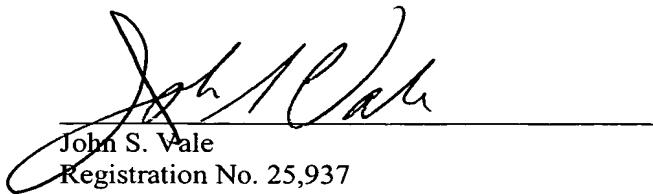
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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: June 2, 2005



John S. Vale
Registration No. 25,937